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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,479	02/22/2002	Gottlieb-Georg Lindner	215150US0	6695

22850 7590 07/28/2010

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EXAMINER	
NGUYEN, NGOC YEN M	
ART UNIT	PAPER NUMBER
1793	

NOTIFICATION DATE	DELIVERY MODE
07/28/2010	ELECTRONIC

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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GOTTLIEB-GEORG LINDNER, ROBERT KUHLMANN,
and CLAUS-PETER DREXEL

Appeal 2010-000463
Application 10/079,479
Technology Center 1700

Oral Hearing Held: June 10, 2010

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and
STEPHEN WALSH, *Administrative Patent Judges.*

APPEARANCES:

ON BEHALF OF THE APPELLANT:

JAY E. ROWE, JR., PH.D.
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The above-entitled matter came on for hearing on Thursday, June 10, 2010, commencing at 2:31 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Christine L. Loeser, Notary Public.

THE COURT: As you know, you have 20 minutes. You can begin when ready.

MR. ROWE: Formally, may it please the Court, my name is Jay Rowe, I am a patent agent with Oblon Spivak and I'm here to represent the Appellant in this case.

I would like to point out initially that in the Examiner's Answer, the Examiner in the response to argument section on page 8 indicated that whereas previously, there were rejections based on both inherency and on obviousness, that the rejection on inherency is no longer relied on and that apparently the only rejection remaining is the obviousness rejection, the obviousness being the combination of EP 755 and the Turk reference.

So my remarks will be addressing just that obviousness rejection unless there are other questions that you may have or wish to discuss that.

I would like to go right to the Examiner's statement that it would have been obvious to one of ordinary skill in the art to optimize the alkali number of the process conditions of EP 755 as suggested by the Turk reference and then, in close review of the Turk reference, I would like to point out that that reference states as an objective in column 4 that the goal is to have a high DBP value for the precipitated silica to which it is directed.

I would point out that that's actually in the opposite direction of what the Appellants are striving for in their invention. The Appellants in the

precipitated silica at hand are looking for a product which has high absorptivity for hydrophilic-type materials.

And in a very complex world of precipitated silica, where the surface characteristics, both physically and chemically, are very much dependent upon a whole myriad of process and conditions, the Appellants have determined that, in addition to the more or less conventional measures of the surface characteristics of the silica, they have added this sears number which is an indication of the number and density of silanol groups on the surface. And they have also used a ratio of the DBP number to the choline chloride absorptivity, which I would point out then since the DBP is hydrophobic, choline chloride is being indicated as a hydrophilic-type material, actually it is ionic, gives a relative sense as to the balance of hydrophobic versus hydrophilic character of the surface composition.

So when you go to the 379, the Turk reference and he's stated in his objective that the goal is to have a project which has a high DBP value, in other words, a surface which a has high character, high absorptivity for hydrophobic materials, that reference is actually going in the opposite direction than what the invention at hand is directed toward.

I point out, too, that in the description that Turk provides, in multiple places, he points out that in addition to the processing conditions that are basically recognized as somewhat conventional, pH, time of precipitation, temperature, those kinds of things, that everything that is important in his invention is related to the dispersion technique under which he promotes the precipitation of the silica.

So for example, in column 5, he will talk about variation of things but it's the feature of the invention that by varying and combining different dispersing

factors such as throughput frequency, timing, duration of the dispersion, it's possible to get the structure with a high DBP value.

So he's throwing in there a variable which is not present in the EP 755 type invention.

JUDGE WALSH: May I ask you a question about that? The example in EP 755 that the Examiner relied on for the obviousness of the product was a silica that had been prepared with a constant alkali number of 7.

MR. ROWE: That's correct.

JUDGE WALSH: I didn't understand your point that there wasn't anything like that in the 755.

MR. ROWE: What Turk describes is that in addition to something such as the alkali number, that it is the requirement that, during the course of this precipitation, he is constantly circulating it through a dispersing mechanism or medium to break down the particle size and that, without that particular mechanical dispersion, he does not get the properties that he is seeking in the invention that he describes. There is, in the EP reference --

JUDGE WALSH: So are you saying that both of those factors are important in Turk?

MR. ROWE: Yes.

JUDGE WALSH: The alkali number and the circulation?

MR. ROWE: I'm saying the circulation is absolutely required, the dispersion is required and I would like to point out that, going forward with that, if you go to table 6 in the Turk reference, bear with me a second here, I'm sorry, table 4 on, in column 15 and it continues over into column 16, you will see that he uses an alkali number.

He shows that the DBP number actually increases with increasing alkali

number which would then lead to the conclusion for one of ordinary skill in the art that by increasing the alkali number from the 7, which is described in the EP reference, that you would get, correspondingly, an increase in the DBP number, which represents an increase in the hydrophobic character of the surface, not the affinity for hydrophilic materials which is what is being sought after in the present invention.

So it is going, it would appear to go in the opposite direction. The Examiner has said it would be obvious to read the description of Turk into or change the alkali number according to that description in order to optimize or increase the hydrophilic character, the choline chloride number or correspondingly, the sears number in the precipitated silica.

I would say that one of ordinary skill in the art would not read Turk and take away from that that increasing the alkali number would, in fact, lead in the direction of increasing the hydrophilic character of the precipitated silica.

JUDGE WALSH: Did Turk disclose a pattern relating the alkali number to choline chloride?

MR. ROWE: The only description that Turk has of choline chloride is found in example 26 in column 20 and, in this case, he indicates, all he does is take example 1 and example 22.

Example 22 doesn't give the alkali number. So you would assume that because he says in his text that an alkali of 30 is the preferred number that since it's not described here, that perhaps that is where he is going. And I'm just making that as an assumption because it is not there.

I would point out in that example, he indicates that the choline chloride weight percentage absorption is 55 percent and 58 percent, respectively, between the two samples and if you correlate that to the numbers that are

used in the current description, the current specification, that would lead to a DBP ratio, DBP to choline chloride ratio that's greater than 2.

So what it is saying is that in accord with what Turk is describing, he has taken the hydrophobic character of the surface and elevated that in comparison to the hydrophilic character, which is the opposite direction of what the claimed invention is trying to accomplish or does accomplish.

So I would say based on that, that one of ordinary skill in the art would not look to Turk, would not get description or motivation to increase the alkaline number for the purpose of increasing the hydrophilic character of the precipitated silica, let alone looking at a sears number.

Therefore, the obviousness rejection should be reversed. It doesn't hold.

Any questions?

JUDGE TIMM: No questions.

JUDGE WALSH: No questions.

THE COURT: Thank you very much, counselor. Proceeding is terminated.

Whereupon, the proceedings, at 2:42 p.m., were concluded.